

REMARKS

Claims 1-29 are pending in this application. By this Amendment, the specification and claims 1, 6, 7, 9-11, 14 and 20 are amended and new claims 27-29 are added. Various amendments are made to the claims for clarity and are unrelated to issues of patentability.

The Office Action objects to claims 1, 3, 5, 7-10, 14, 15, 17 and 21-25 because the symbol (/) in BSC/PCF apparently is not clear. Applicant respectfully submits that this terminology is clear and definite to one skilled in the art. In other words, one skilled in the art would clearly understand the meaning of BSC/PCF. However, in order to further prosecution, applicant has amended independent claims 1, 9, 14 and 20 to recite the BSC/PCF including a base station controller (BSC) and packet controller having a packet control function (PCF). Thus, the symbol "/" should be clear. Withdrawal of the objection is respectfully requested.

The Office Action rejects claim 10 under 35 U.S.C. §112, second paragraph. It is respectfully submitted that the above amendments obviate the grounds for rejection. In particular, applicant believes the above amendment to claim 10 removes the confusing terminology for the claim. Withdrawal of the rejection is respectfully requested.

Applicant gratefully acknowledges the Office Action's indication that claims 10, 17-19 and 23-25 contain allowable subject matter. New independent claims 27-29 relate to at least one of these claims and therefore are believed to define patentable subject matter at least for similar reasons.

The Office Action rejects claims 11 and 13 under 35 U.S.C. §102(e) over U.S. Patent Publication 2001/0050907 to Madour et al. (hereafter called Shafik as indicated in the Office

Action). The Office Action also rejects claims 14-16 and 20-22 under 35 U.S.C. §102(e) over U.S. Patent Publication 2002/0021681 to Madour (hereafter Madour). Still further, the Office Action rejects claims 1-5 and 9 under 35 U.S.C. §103(a) over Madour in view of Shafik. Additionally, the Office Action rejects claim 6-8 under 35 U.S.C. §103(a) over Madour, Shafik and further in view of U.S. Patent Publication 2002/0046277 to Barna et al. (hereafter Barna). The Office Action further rejects claim 12 under 35 U.S.C. §103(a) over Shafik and rejects claim 26 under 35 U.S.C. §103(a) over Madour. The rejections are respectfully traversed.

Applicant attaches a verified translation of the Korean priority document for this application (i.e., Korean Application No. 67014/2000 filed November 11, 2000). Applicant respectfully submits that the rejected claims are supported by the Korean priority document. The filing date of the Korean priority document predates the non-provisional application filing dates of both Shafik and Madour. Thus, the Shafik and Madour publications are not prior art to the rejected claims of the present application.

Independent claim 11 recites receiving, at a mobile switching center (MSC), location renewal information of a mobile station that is performing a dormant handoff, determining whether the mobile station is in a state for executing the dormant handoff, when the location renewal information is received, and releasing a radio packet link by transferring registration renewal information from the MSC to a first base station controller/ packet controller function, if the mobile station is in the state for executing the dormant handoff.

The Office Action cites Shafik to show the features of independent claim 11. As stated above, the Shafik publication is not prior art to the rejected claims of the present application.

Additionally, Shafik and the Shafik provisional application do not teach or suggest all the features of independent claim 11. More specifically, the Office Action relies on Shafik's paragraph [0035] to allegedly show features relating to a dormant handoff. However, Shafik's paragraph [0035] does not relate to a dormant handoff. Rather, paragraph [0035] relates to power-down registration. Shafik relates to power-down and not to releasing a radio packet link. For example, the BSC may send a location update request to the MSC with a power-down notification. The MSC may then check if the MS is hosting a packet data session, and if so, determine whether the packet data session is dormant. This does not teach or suggest a dormant handoff as recited in independent claim 11. This is, a determination that a packet data session is dormant does not suggest receiving information of a mobile station that is performing a dormant handoff. Accordingly, Shafik and the Shafik provisional application do not teach or suggest receiving location renewal information of a mobile station that is performing a dormant handoff and determining whether the mobile station is in a state for executing the dormant handoff, as recited in independent claim 11. Thus, independent claim 11 defines patentable subject matter.

Independent claim 14 recites a method of performing a dormant packet handoff during a first communication link between a mobile station and a source packet data serving node (PDSN). The method includes communicating a dormant handoff message from a mobile switching center (MSC) to the source BSC/PCF, and terminating the first communication link between the mobile station and the source PDSN, in response to the dormant handoff message.

The Office Action cites Madour to show the features of independent claim 14. As stated above, the Madour publication is not prior art to the rejected claims of the present application.

Additionally, Madour and the Madour provisional application do not teach or suggest all the features of independent claim 14. More specifically, the Office Action relies on Madour's [0033]-[0035] to show features relating to performing a dormant packet handoff. However, paragraphs [0033]-[0035] do not relate to a dormant handoff. That is, while paragraphs [0033]-[0035] disclose a handoff, there is no suggestion for a dormant handoff. Furthermore, Madour has no suggestion in the entire specification of a dormant handoff. The features of independent claim 14 relate to a dormant handoff. However, Madour does not suggest any features relating to a dormant handoff. Thus, Madour does not teach or suggest all the features of claim 14. The Madour provisional application also does not teach or suggest all the features of claim 14. Accordingly, independent claim 14 defines patentable subject matter.

Independent claim 20 defines patentable subject matter at least for similar reasons as set forth above. That is, the Office Action cites Madour to show the features of independent claim 20. However, independent claim 20 recites a mobile switching center (MSC) that communicates a dormant handoff message to the source BSC/PCF, after the second communication link is established, wherein the dormant handoff message initiates the termination of the first communication link by the source PDSN and the source BSC/PCF. Madour and the Madour provisional application do not teach or suggest these features for at least the reasons as set forth above. That is, Madour does not relate to the claimed dormant handoff message. Thus, independent claim 20 defines patentable subject matter.

Still further, independent claim 1 recites determining with a mobile switching center whether a mobile station performs a dormant handoff into an area of a destination base station

controller/ packet controller function (BSC/PCF) and providing information of the dormant handoff from the mobile switching center to an original BSC/PCF, when the mobile station performs the dormant handoff. For at least the reasons set forth above, Madour, the Madour provisional application, Shafik and the Shafik provisional application do not teach or suggest all the features of independent claim 1. Thus, independent claim 1 defines patentable subject matter.

Independent claim 9 recites discriminating with a mobile switching center whether a mobile station performs a dormant handoff into an area of a destination base station controller/ packet controller function (BSC/PCF) and providing information of the dormant handoff from the mobile switching center to an original BSC/PCF, when the mobile station performs the dormant handoff. For at least the reasons set forth above, Madour, the Madour provisional application, Shafik and the Shafik provisional application do not teach or suggest all the features of independent claim 9. Thus, independent claim 9 defines patentable subject matter.

Each of the dependent claims depends from one of the independent claims and therefore defines patentable subject matter at least for this reason. In addition, the dependent claims recite features that further and independently distinguish over the applied references.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-30 are earnestly solicited. If the Examiner believes that any additional changes would place the application in

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better condition for allowance, the Examiner is invited to contact the undersigned attorney,
David C. Oren, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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Attachment: Verified Translation of
Korean Application No. 10-2000-0067014

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